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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/592,845	06/13/2000	Mark Rosenberg	5547	5201

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WASHINGTON, DC 20006

EXAMINER

SUBRAMANIAN, NARAYANSWAMY

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 01/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/592,845

Applicant(s)

ROSENBERG, MARK

Examiner

Narayanswamy Subramanian

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-84 is/are pending in the application.
- 4a) Of the above claim(s) 7-42 and 49-84 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 43-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This is in response the communication dated October 30, 2003. Examiner acknowledges the provisional election of claims 1-6 and 43-48 without traverse during the telephonic interview with Mr. Sean Wooden on September 5, 2003 and recorded in the interview summary (Paper No. 7) and confirmation of this election by telephone on January 9, 2004. The communication of October 30, 2003 indicates election of claims 1-6 and 37-42. Applicant is respectfully requested to confirm the proper election of claims in response to this office action. Claims 7-42 and 49-84 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention. Applicant is respectfully advised to cancel the non-elected claims in response to this office action. Claims 1-6 and 43-48 have been examined. The rejections are stated below.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claims 43-48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. For these claims, it is not clear if the term "investment structure" implies a method or an apparatus. Clarification is required.

#### ***Claim Rejections - 35 USC § 101***

4. The claimed invention is directed to non-statutory subject matter. Claims 1-6 are drawn to a method for providing an investment structure and claims 43-48 are drawn to an investment structure that are not tied to any technological art. The claimed invention is directed merely to

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human making mental computations and manually plotting results on paper, and thus is nothing more than an abstract idea, which is not tied to any technological art, and is not a useful art as contemplated by the constitution. (See Ex parte Bowman, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001) (Unpublished))

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-6 and 43-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edelman (US Patent 6,064,986) in view of Hagan (US Patent 6,061,661).

With reference to claims 1, 2, 6, 43, 44 and 48, Edelman teaches a method for providing an investment structure and an investment structure, comprising: receiving funds to be invested (See Edelman Claim 1c); investing a first portion of the funds in a fixed component generating principal plus fixed interest (See Edelman Column 17 lines 56-59 and Column 17 line 66 – Column 18 line 3); investing a second portion of the funds in a contingent component generating contingent interest (See Edelman Column 26 lines 38-43); re-investing at least a portion of the fixed interest in the fixed component (See Edelman Column 21 lines 61-64); and re-investing at least a portion of the contingent interest in the contingent component (See Edelman Column 21 lines 61-64). Contingent component is interpreted to include equity investments like S&P 500

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Index because their returns are not fixed and their performance is contingent on the performance of individual securities that make up the index. Edelman also teaches the steps of including using a trustee for investing the fixed component (See Edelman claim 1f) and distributing the initial investment and accrued interest after an investment period (See Edelman claim 1m, Column 21 lines 53-55).

Edelman does not explicitly teach the step of using a partnership for investing the contingent component.

Hagan teaches the step of using a limited partnership for investing. Limited partnerships are a type of partnership that limits the liability of the limited partners. Using this form of investment structure enables the pass through of income while limiting the liability of the limited partners.

It would have been obvious to one with ordinary skill in the art at the time of the current invention to combine the steps taught by Hagan to the disclosure of Edelman. The combination of the disclosures taken as a whole suggests that the investors would have benefited from the advantages offered to at least a part of their investments by the partnership structure.

With reference to claims 3-5 and 45-47, Edelman and Hagan combined teach the method and investment structure of claims 1 and 43 respectively.

Edelman and Hagan combined do not explicitly teach the steps of investing sixty to ninety percent of the funds in the fixed component and investing ten to forty percent of the funds in the contingent component; the fixed component comprising one or more of treasury notes, AAA-rated securities, AA-rated securities, municipal bond notes, or variable rate notes; and contingent component comprising one or more of futures, options, or forward positions.

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Official notice is taken that these steps are old and well known in the art. The step of investing sixty to ninety percent of the funds in the fixed component and the remaining in the contingent component minimizes the risk to the investors while letting them benefit from the potential higher returns of the contingent component. Investing in a fixed component comprising one or more of treasury notes, AAA-rated securities, AA-rated securities, municipal bond notes, or variable rate notes allows the investor to minimize their risk and in some instances benefit from the tax advantages offered by some of these securities (Munis for instance). Investing in a contingent component comprising one or more of futures, options, or forward positions allows an investor to speculate and reap the rewards in the form of potential higher returns.

It would have been obvious to one with ordinary skill in the art at the time of the current invention to combine these steps to the disclosure of Hagan and Edelman. The combination of the disclosures taken as a whole suggests investors would have benefited from minimizing their risk and the potential higher returns of the contingent component.

### *Conclusion*

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (703) 305-4878. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (703) 308-1065. The fax number for Formal or Official faxes and Draft or Informal faxes to the Patent Office is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

N. Subramanian  
January 9, 2004

Richard Weisberger  
Primary Examiner